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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/365,066	07/30/1999	JOSEPH FRUTUOSO	5053-23300	1321

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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/365,066

Applicant(s)

FRUTUOSO ET AL.

Examin r

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,12-15,17-34,36 and 38-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,12-15,17-34,36 and 38-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the RCE filed on April 28, 2003, which paper has been placed of record in the file.
2. Claims 9, 11, 16, 35, and 37 are canceled. Claims 63-70 are added.
Claims 1-8, 10, 12-15, 17-34, 36, and 38-70 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-8, 10, 12-15, 17-34, 36, and 38-70 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10, 12-15, 17-28, 32-34, 36, and 38-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al (hereinafter Borghesi), U.S. Patent No. 5,950,169 in view DiRienzo, U.S. Patent No. 6,003,007, and further in view of Richards, U.S. Patent No. 6,408,303.

Regarding claim 1, Borghesi discloses a method for processing receiving trading partner transactions comprising:

receiving at least one incoming transaction from at least one sending trading partner (column 16, lines 4-10);

reading additional information from an administration system in data communication with a computer system, wherein the additional information is read in response to receiving at least one incoming transaction from the at least one sending trading partner, and wherein the additional information is identified by at least one business rule (column 12, lines 14-58);

generating at least one outgoing transaction in response to reading the additional information from the administration system (column 12, line 59-column 13, line 60);

sending at least one outgoing transaction to at least one receiving trading partner (column 16, lines 46-49).

Borghesi does not teach receiving at least incoming transaction from at least one sending trading partner through an industry clearinghouse system; and translating at least one incoming transaction from a first data format to a second data format, wherein the first data format comprises a data format of an industry clearinghouse system. However, DiRienzo discloses receiving at least incoming transaction from at least one sending trading partner through an industry clearinghouse system and the first data format comprises a data format of an industry clearinghouse system (see figure 6A and column 17, lines 41-53, the clearinghouse system sends the incoming transaction to the insurance company using a standard claim format). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the feature above with Borghesi's for the purpose of providing the clearinghouse system as an intermediate between trading partners, servers as an electronic routing system for the claims and checks to determine if the information is

completed. Moreover, Richards discloses translating at least one incoming transaction from a first data format to a second data format (column 1, lines 45-55). Most of trading partners' internal data processing systems do not use data and file standards that conform to the EDI standards or other standard communication formats. Thus, in order to receive and processing data that conform to various EDI standards, the incoming data need to be translated to a data format that is compatible with the trading partner's internal data processing system. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the feature above with Borghesi's for the purpose of time-consuming because the incoming data need not to be re-entered to another data format compatible with the trading partner's internal data processing system.

Regarding claim 2, Borghesi further discloses the at least one business rule comprises one or more keywords (column 12, lines 19-29).

Regarding claims 3-4, Borghesi further discloses the at least one business rule comprises one or more logical operators and a string of at least one keyword and at least one operator, and wherein the business rule is entered into the computer system by a user via a user interface.(column 10, lines 29-55 and figures 9-12).

Regarding claim 5, Borghesi further discloses the outgoing transaction comprises the additional information read from the administration system (column 13, lines 60-64).

Regarding claims 6-7, Borghesi further discloses the reading additional information from the administration system in response to the computer system receiving the incoming transaction from the at least one sending trading partner further comprises: extracting the additional information from the administration system

according to search criteria wherein search criteria comprise one or more keywords.(column 12, lines 14-30).

Regarding claim 8, Borghesi further discloses queuing the outgoing transaction in response to the computer system generating the outgoing transaction (column 13, line 60-column 14, line 8).

Regarding claim 10, DiRienzo further discloses the computer system sending the outgoing transaction to the at least one receiving trading partner through an industry clearinghouse system (see figure 6A, the provider send the outgoing transaction to the clearinghouse system). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the feature above with Borghesi's for the purpose of providing the clearinghouse system as an intermediate between trading partners, servers as an electronic routing system for the claims and checks to determine if the information is complete.

Regarding claim 12, Borghesi further discloses the incoming transaction is an insurance-related transaction (column 4, lines 20-22).

Regarding claims 52-56, Borghesi further discloses at least one business rule comprises: a receiving trading partner identifier, an administration system identifier, a transaction identifier, a transaction status, a sending trading partner identifier (column 9, lines 18-32).

Regarding claim 57, Borghesi further discloses the business rule is entered into a database (column 12, lines 14-22).

Regarding claim 13, claim 13 contains similar limitations found in claim 1 above, and is rejected by the same rationale. Moreover, Borghesi discloses a system comprising: a CPU; a database coupled to the CPU; an administration system coupled to the CPU; a memory coupled to the CPU, wherein the memory stores one or more

computer programs executable by the CPU (column 6, lines 5-32); wherein the computer programs are executable to:

store a trading relationship between trading partners of a transaction, wherein the trading relationship is stored in the database, wherein at least one trading partner is a sending trading partner and at least one trading partner is a receiving trading partner (column 4, lines 25-46);

receive an incoming transaction from the at least one sending trading partner (column 16, lines 4-10);

read additional information from the administration system in response to receiving the incoming transaction from the at least one sending trading partner, wherein the additional information is identified by at least one business rule (column 12, lines 14-58);

generate an outgoing transaction in response to reading the additional information from the administration system (column 12, line 59-column 13, line 60);

send the outgoing transaction to the at least one receiving trading partner, wherein the at least one receiving trading partner is identified in the trading relationship (column 16, lines 46-49).

Regarding claim 14, Borghesi further discloses the business rule comprises a string of at least one keyword and at least one operator, and wherein the business rule is entered into the computer system by a user via a user interface (column 10, lines 29-55 and figures 9-12).

Regarding claim 15, Borghesi further discloses the at least one business rule is defined by a user through a user interface (column 9, lines 52-55).

Regarding claim 17, Borghesi further discloses the incoming transaction is an insurance-related transaction (column 4, lines 20-22).

Claims 18-22, 28, 32-34, 36, 38, 58-62 are written in computer software that parallel limitations found in claims 1-4, 57, 5-8, 10,12, 52-56 as discussed above, therefore, are rejected by the same rationale.

Regarding claims 23-27, Borghesi further discloses the administration system form which additional information is read is specified by a map, wherein the map comprises a relationship between the outgoing transaction and a source for the additional information and the map is specified by a user through a user interface; generating the map comprises: selecting one or more source fields, wherein each source field corresponds to the source for the additional information; selecting a destination field, wherein each destination field corresponds to the outgoing transaction, the value of the destination field is a sum of respective values of the one or more selected source fields, a value of the destination field as a function of the one or more source fields.(figures 10-12, column 11, lines 33-44 and column 13, lines 49-57).

Regarding claims 39-44, Borghesi further the outgoing transaction is an insurance-related transaction, an annuity asset pricing transaction, a positions and valuation focused refresh transaction, an insurance pricing transaction, a commission settlement transaction (column 4, lines 25-30, column 13, lines 45-53, column 10, lines 25-28, and column 16, lines 12-15).

Regarding claim 45, Borghesi further discloses the sending trading partner is the receiving trading partner (column 16, lines 4-22).

Regarding claim 46, Borghesi further discloses the carrier medium is a memory medium (column 6, lines 5-14).

Claims 47-51 are written in computer software that parallel limitations found in claims 13, 14, 57, 12, 46 discussed above, therefore are rejected by the same rationale.

Regarding to claims 63-70, DiRienzo discloses the industry clearinghouse system comprises an insurance industry clearinghouse system, an insurance annuity clearinghouse system (see figure 6A and column 17, lines 41-53). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the feature above with Borghesi's for the purpose of providing the clearinghouse system as an intermediate between trading partners, servers as an electronic routing system for the claims and checks to determine if the information is completed.

6. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al, U.S. Patent No. 5,950,169 in view DiRienzo, U.S. Patent No. 6,003,007, further in view of Richards, U.S. Patent No. 6,408,303, and further in view of Wamsley et al (hereinafter Wamsley), U.S. Patent No. 5,956,687.

Regarding claims 29-31, Borghesi, DiRienzo, and Richards do not teach the computer system implements storing a schedule in memory, wherein the schedule relates to the incoming transaction, and wherein the schedule comprises: a predetermined time for receiving the incoming transaction from the at least one sending trading partner, a predetermined time for reading the additional information from the administration system, a predetermined time for sending the outgoing transaction to the at least one receiving trading partner. Wamsley teaches such feature above (see column 32, line 49-column 33, line 20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Borghesi's for the purpose of providing more convenient for the user to receiving an incoming transaction at a specified date and time.

Conclusion

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7. Claims **1-8, 10, 12-15, 17-34, 36, and 38-70** are rejected.

8. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Moore et al. (US 5,930,759) discloses the method and system for processing health care electronic data transactions, and the use of an industry clearinghouse system (see column 5, lines 8-25).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:

(703) 305-7687, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen
June 2, 2003

A handwritten signature in black ink, appearing to read 'Jeffrey PWU', written in a cursive style.

JEFFREY PWU
PRIMARY EXAMINER